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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,875

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John S. Manka

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06/25/2008

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EXAMINER

HARLAN, ROBERT D

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,875	Applicant(s) MANKA ET AL.	
	Examiner Robert D. Harlan	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al., U.S. Patent No. 5,914,365 (hereinafter "Chang"). Chang teaches an aqueous binder composition containing a urea-formaldehyde resin modified with a water-soluble styrene maleic anhydride copolymer. See Chang, Abstract, col. 2, line 48 through col. 3, line 30. The ration of urea-formaldehyde/SMA is 99.9/0.10 to 70/30. See Chang, col. 6, lines 11-27.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2-4, 6-7 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al., U.S. Patent No. 5,914,365 (hereinafter "Chang") in combination with Suzuki et al., U.S. Patent No. 5,064,717 (hereinafter "Suzuki"). Chang teaches an aqueous binder composition containing a urea-formaldehyde resin modified with a water-soluble styrene maleic anhydride copolymer. See Chang, Abstract, col. 2, line 48 through col. 3, line 30. The ration of urea-formaldehyde/SMA is 99.9/0.10 to 70/30. See Chang, col. 6, lines 11-27. The

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present invention differs from Chang in that the present invention requires a 2-acrylamido-2-methylpropane sulfonic acid monomer, use as a wood adhesive, and surfactant. Suzuki teaches, in analogous art, an (meth)acrylate polymerized with acrylamido-2-methylpropane sulfonic acid monomer, mixed with a urea-formaldehyde plasticizer and a surfactant emulsifier. See Suzuki, col. 3, lines 41-42, col. 4, line 49 through col. 5, line 13 and col. 10, lines 21-40. The use of cellulose in claims 6-7 is an end use without patentable weight because the adhesive is what is claimed and is taught by the prior art. In view of Suzuki, one having an ordinary skill in the art would be motivated to modify Chang by using an 2-acrylamido-2-methylpropane sulfonic acid monomer and surfactant because the references each involve water soluble polymers and urea-formaldehyde polymer as an adhesive. Such modification would be obvious because one would expect that the use of binder as taught by Chang would be similarly useful and applicable to the adhesives taught in Suzuki.

6. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al., U.S. Patent No. 5,914,365 (hereinafter "Chang") in combination with Suzuki et al., U.S. Patent No. 5,064,717 (hereinafter "Suzuki"). Although Chang in

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combination with Suzuki does not specifically disclose all the characteristics and properties of the claimed adhesive (present claims 8-11) disclosed in the present claims, based on the substantially identical based polymers that make up the adhesive composition of the claimed invention, the Examiner has a reasonable basis to believe that the properties claimed in the present invention is inherent in the composition disclosed by Suzuki and Chang. Because the PTO has no means to conduct analytical experiments, the burden of proof is shifted to the Applicants to prove that the properties are not inherent. See In re Best, 195 USPQ 430 (CCPA 1977); In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert D. Harlan whose telephone number is (571) 272-1102. The examiner can normally be reached on Mon-Thu, 10 AM - 8 PM.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David W. Wu can be reached on (571) 273-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert D. Harlan/
Primary Examiner
Art Unit 1796

rdh